

Serial No.: 08/482,283

IN THE SPECIFICATION:

Please amend the specification as follows:

Page 25, line 12, after "activity.", insert --Preferably, the degree of homology is in excess of 70 percent, more preferably in excess of 80 percent and even more preferably in excess of 90 percent. A particularly preferred group of inhibitors are in excess of 95 percent homologous with the native inhibitor. The percentage homology as described is calculated as the percentage of amino acid residues found in the smaller of the two sequences that align with identical amino acid residues in the sequence being compared when four gaps in a length of 100 amino acids may be introduced to assist in that alignment as set forth by Dayhoff, M.D. in Atlas of Protein Sequence and Structure, Vol. 5, p.124 (1972), National Biochemical Research Foundation, Washington, D.C.--

R E M A R K S

Informalities

At pages 2 and 3 of the Office Action, the Examiner addressed informalities concerning the drawing figures and declaration. As permitted under 37 C.F.R. § 1.111(b), applicants request that these informal matters be held in abeyance until the application is otherwise indicated to be allowable.

At page 2, the Examiner requested amendment of the title. Applicants amended the title as requested.

LAW OFFICES
FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
STANFORD RESEARCH PARK
700 HANSEN WAY
PALO ALTO, CALIF. 94304
650-849-6600

Serial No.: 08/482,283

Double Patenting Rejections

The Examiner rejected claims 22 to 25 over U.S. Patent No. 5,075,222 (the '222 patent) under the judicially created doctrine of obviousness-type double patenting. Action at page 4. If the Examiner holds that the presently pending claims are otherwise allowable, applicants will file a terminal disclaimer in view of the '222 patent. Thus, this rejection will be obviated. Applicants are not filing such a disclaimer at this time, since the claims may change prior to an indication of allowance, and the claims pending after such changes may not be subject to a double patenting rejection.

The Examiner rejected claims 24 and 25 over U.S. Patent No. 5,453,490 (the '490 patent) under the judicially created doctrine of obviousness-type double patenting. Action at page 5. If the Examiner holds that the presently pending claims are otherwise allowable, applicants will file a terminal disclaimer in view of the '490 patent. Thus, this rejection will be obviated. Applicants are not filing such a disclaimer at this time, since the claims may change prior to an indication of allowance, and the claims pending after such changes may not be subject to a double patenting rejection.

Rejection Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 22 to 25 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Action at page 5. First, the Examiner contends that the recitation "70% homologous" is indefinite "without disclosure as to how homology is to be calculated." *Id.*

LAW OFFICES
FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
STANFORD RESEARCH PARK
700 HANSEN WAY
PALO ALTO, CALIF. 94304
650-849-6600

Serial No.: 08/482,283

Applicants have amended the specification to include a description of how the percentage homology is calculated. The material in that amendment was obtained from U.S. Patent No. 5,075,222, which issued from U.S. Patent Application Serial No. 07/506,522, which is specifically incorporated by reference in the present application, e.g., at page 1, first paragraph. Specifically, the inserted material is found at column 5, line 64, to column 6, line 9, of U.S. Patent No. 5,075,222.¹ Thus, this basis for the rejection is moot since the specification describes how one skilled in the art would calculate "70% homologous" as presently claimed.

Second, the Examiner contends that claim 23 is indefinite "because it does not clearly set forth that the recombinant cell has been transformed or transfected with an IL-1*i*- encoding nucleic acid." Action at page 5, last paragraph. Further, the Examiner contends that the claim could read on a natural cell. *Id.* Applicants respectfully traverse this basis for the rejection.

Claim 23 is directed to "a recombinant host cell." Applicants respectfully assert that one skilled in the art would understand that the claim term "recombinant host cell" would not encompass a naturally occurring cell. Thus, applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph.

¹ Applicants corrected a typographical error in U.S. Patent No. 5,075,222. Specifically, that patent reads "Preferably, the degree of homology in excess of 70 percent . . ." It is clear that this sentence should read "Preferably, the degree of homology *is* in excess of 70 percent . . .".

Serial No.: 08/482,283

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

By:


M. Paul Barker
Registration No. 32,013

Date: April 23, 1999

LAW OFFICES

FINNEGAN, HENDERSON,
FARABOW, GARRETT
& DUNNER, L.L.P.
STANFORD RESEARCH PARK
700 HANSEN WAY
PALO ALTO, CALIF. 94304
650-849-6600